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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,971

11/22/2006

Oz Cabiri

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20999 7590 07/12/2010  
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EXAMINER

MENDEZ, MANUEL A

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

07/12/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,971	<b>Applicant(s)</b> CABIRI ET AL.	
	<b>Examiner</b> Manuel A. Mendez	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/24/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) Claims 125-131, 379, 390, 132, 138, 140, 141, 146-148, 152, 156-157, 163, 167, 168, 375-378, 380, 383, 384, 225-229, 385, 391, and 388 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are Claims 125-131, 379, 390, 132, 138, 140, 141, 146-148, 152, 156-157, 163, 167, 168, 375-378, 380, 383, 384, 225-229, 385, 391, and 388 .

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/22/2006, 02/05/2007, 04/05/2007, 08/16/2007, 09/11/2007, 03/20/2008, and 07/29/2008..

## DETAILED ACTION

### *Election/Restrictions*

In response to the arguments presented by applicant in relation to the Election and Restriction requirement dated 02/24/2010, the examiner of record finds applicant's arguments persuasive, and therefore, will examine the claims in Group II that were elected by the applicant without traverse. In order to expedite the prosecution of this application, applicant is respectfully invited respond to the following rejections.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 125, 225, and 388 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrick (US 4,596,381).**

The Hamrick patent shows in figure 1, a system (10) (column 4 line 61 - column 6 line 31 ) for use with a source of fluid pressure (18) (as best seen in Figure 1) (column 4 line 61 -column 6 line 31), comprising **a guide member** (14) (as best seen in Figure 1) (column 4 line 61 - column 6 line 31) at least partially insertable into a proximal opening of a body lumen (elements C) (as best seen in Figure 1) (column 4 line 61 - column 6 line 31), said guide member is formed with a passageway connectable to the source of fluid pressure (as best seen in Figure 1) (column 5 lines 42-53) and operable to convey the fluid pressure into the lumen when the guide member is inserted into the body

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lumen (as best seen in Figures 1 and 2) (column 5 lines 42-53), said guide member thereby allowing application of said fluid pressure upon the inner walls of the body lumen (element b) (as best seen in Figures 1 and 2) (column 5 line 42 - column 6 line 31); **an elongate carrier** (12) (as best seen in Figures 1 and 2) (column 4 line 61 - column 6 line 31) arranged for sliding movement through said guide member (as best seen in Figure 1) (column 5 lines 42-53); and **an inflatable piston head** (20) (as best seen in Figure 2) (column 4 line 61 - column 6 line 31) mounted on said carrier (as best seen in Figure 2) (column 4 line 61 - column 6 line 31), the piston head having a proximal side (the leftwards side as seen in Figure 2) and a distal side (the rightwards side as seen in Figure 2) and configured such that once the piston head is inflated it is configured to be advanced distally in the body lumen (as best seen in Figures 1 and 2) (column 4 line 61 - column 6 line 31), due to a fluid pressure difference between the fluid pressure acting on the proximal end of the piston head and a fluid pressure acting on the distal side thereof (column 4 line 61 - column 6 line 31), thereby propelling said piston head together with said carrier distally into the body lumen (as best seen in Figures 1 and 2) (column 4 line 61 - column 6 line 31). 9. 10. 11.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 126-131, 379, 390, 132, 138, 140, 141, 146-148, 152, 156-157, 163, 167, 168, 375-378, 380, 383, 384, 226-229, 385, and 391 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick (US 4,596,381 ) in view of Voloshin et al. (WO 00/44275, hereinafter Voloshin).**

Hamrick discloses the claimed invention, as set forth and cited above, except for expressly disclosing the system further comprising:

- **a vent tube** passing through said piston head, having an opening distal to said piston head through which fluid is ventable to outside of said body lumen;
- **an image-capturing device** mounted on said carrier, wherein said image-capturing device is distal to said piston head;
- **a power supply tube** passing through said carrier and connected to said image-capturing device;
- **an auxiliary piston head** mounted on said carrier proximal to the piston head, wherein said auxiliary piston head is fixed axially to said carrier at a fixed distance from the piston head, and wherein said auxiliary piston head is inflatable; or
- wherein said carrier includes an auxiliary-piston-head passageway in fluid communication with said auxiliary piston head and connectable to an auxiliary-piston-head source of fluid pressure for inflating said auxiliary piston head.

Voloshin teaches a system, comprising a vent tube (the suction ports positively recited in page 7 lines 13-18) passing through a piston head (20) (as best seen in Figure 1) (page 3 line 3 - page 4 line 22 and page 6 line 11 - page 8 line 10) and having an opening distal to said piston head through which fluid is ventable to outside of the

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body lumen (page 7 lines 13-18); a system comprising an image- capturing device (28) (page 6 lines 11-18) mounted on said carrier (as best seen in Figure 1); a system, wherein said image-capturing device is distal to said piston head (as best seen in Figure 1) (page 6 lines 11-18); a system comprising a power supply tube (74) passing through a carrier (36) (as best seen in Figure 1) (page 3 line 3 - page 4 line 22 and page 6 line 11 - page 8 line 10) and connected to the image- capturing device (as best seen in Figure 2) (page 9 lines 15-18); a system comprising an inflatable auxiliary piston head (27) (as best seen in Figure 1) mounted on said carrier proximal to the inflatable piston head (as best seen in Figure 1) (page 6 line 29 - page 8 line 10), fixed axially along said carrier at a fixed distance with respect to the piston head (as best seen in Figure 1) (page 6 line 29 - page 8 line 10), and wherein said carrier includes an auxiliary piston head passageway (the lumen of element 33) in fluid communication with said auxiliary piston head (as best seen in Figure 1) and connectable to a auxiliary piston head source of fluid pressure (33) for inflating said auxiliary piston head (page 6 line 29 - page 8 line 10).

Based on the above observations, for a person of ordinary skill in the art, modifying the apparatus disclosed by Hamrick, with a vent tube, an image-capturing device, a power supply tube, and an auxiliary piston head, as taught by Voloshin, would have been considered obvious in view of the conventionality of these enhancements, and moreover, obvious alternatives in the design of the system.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



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**Claims 125-131, 379, 390, 132, 138, 140, 141, 146-148, 152, 156-157, 163, 167, 168, 375-378, 380, 383, 384, 225-229, 385, 388 and 391 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,635,346.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims identified above, disclose substantially similar structural elements with minor differences that would have been considered obvious by a person of ordinary skill in the art in view of their conventionality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel A. Mendez whose telephone number is 571-272-4962. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Manuel A. Mendez/

Primary Examiner, Art Unit 3763

Manuel A. Mendez  
Primary Examiner  
Art Unit 3763

MM